

**THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

TORVENT LLC,

Plaintiff,

v.

TECHTRONIC INDUSTRIES CO., LTD.;
TECHTRONIC INDUSTRIES NORTH
AMERICA, INC.; ONE WORLD
TECHNOLOGIES, INC.; HOMELITE
CONSUMER PRODUCTS, INC.; HART
CONSUMER PRODUCTS, INC.; HOME
DEPOT U.S.A., INC.; AND WALMART
INC.,

Defendants.

and,

TECHTRONIC INDUSTRIES CO., LTD.;
TECHTRONIC INDUSTRIES NORTH
AMERICA, INC.; ONE WORLD
TECHNOLOGIES, INC.; HOMELITE
CONSUMER PRODUCTS, INC.; HART
CONSUMER PRODUCTS, INC.;

Counterclaim Plaintiffs,

v.

TORVENT LLC, TORVIAN, INC., and
FIRST-TO-INVENT, LLC

Counterclaim Defendants.

Civil Action No. 1:21-cv-00853-JPM

JURY TRIAL DEMANDED

JOINT STIPULATION OF PARTIAL DISMISSAL

WHEREAS, Plaintiff Torvent LLC (“Plaintiff” or “Torvent”) has asserted patent infringement claims against Defendants Techtronic Industries Co. Ltd. (“TTi Co.”), Techtronic Industries North America, Inc. (“TTi NA”), One World Technologies, Inc. d/b/a/ Techtronic Industries Power Equipment (“TTi PE”), Homelite Consumer Products, Inc. (“Homelite”), Hart

Consumer Products, Inc. (“Hart”) (collectively, “TTi”), The Home Depot, U.S.A, Inc. (“Home Depot”), and Walmart Inc. (“Walmart”) (collectively, “Defendants”);

WHEREAS, Counterclaim Plaintiffs TTi have asserted counterclaims and third-party claims jointly against Torvent and third-party defendants Torvian, Inc. (“Torvian”) and First-to-Invent, LLC (“First-to-Invent”) (as stated in Dkt. 83 and Dkt. 84, respectively);

WHEREAS, third-party defendant Torvian has answered [Dkt. 99], and

WHEREAS, TTi contends that third-party defendant First-to-Invent was served on August 18, 2022, but First-to-Invent contends that it has not yet been served and, hence, has not yet answered; and

WHEREAS, the parties wish to narrow the disputes in this case by dismissing certain of Torvent’s infringement claims and TTi’s counterclaims and third-party claims;

Torvent, Defendants, and Torvian hereby stipulate as follows:

TTi agrees to the following:

1. TTi represents that, based on its investigation, the sales report produced as TTi00004805 is correct and accurate to the best of its knowledge as to sales through approximately June 2022, and agrees to inform Torvent in the event it identifies any additional LX50 (also referred to as “1st Generation”) or Pro Cut II (also referred to as “Fixed Head”) unit sales in the United States.
2. TTi represents that it has discontinued the manufacture of the 1st Generation and Fixed Head products for sale in the United States, and represents that it will not resume manufacturing these products in the future for sale in the United States until U.S. Patent No. 8,025,249 (“’249 Patent”), U.S. Design Patent No. 598,254 (“D254 Patent”), and U.S. Design Patent No. 598,255 (“D255 Patent”) have expired or been found invalid. Notwithstanding this provision, the parties agree that TTi may continue to sell any remaining inventory of the 1st Generation and Fixed Head products it currently has in the United States, provided that TTi pays the applicable royalties at the same rates most recently paid for such product sales.
3. TTi also represents that, based on its investigation, it currently has approximately 280 Fixed Head products and 362 1st Generation products in inventory. Once this inventory has been sold, Defendants will not make, have made, or import any additional Fixed Head

or 1st Generation products until the '249 Patent, D254 Patent, and D255 Patent have expired or been found invalid.

4. In response to Torvent's dismissal with prejudice of all claims based on the '249, D254, and D255 Patents, TTi will dismiss with prejudice its (1) First Counterclaim seeking declaratory judgment of non-infringement; and (2) Third Counterclaim based on unjust enrichment. In addition, TTi will also dismiss the First and Third claims recited in TTi's Third Party Complaints against Torvian, Inc. and First-to-Invent, LLC [Dkt. 84].
5. Nothing herein shall be construed as affecting TTi's Second Counterclaim and Third Party Claim alleging breach of contract by Torvent, Torvian, Inc., and First-to-Invent, LLC, or TTi's defenses against Torvent's claims alleging infringement of U.S. Patent Nos. 9,516,807 ("807 Patent"), 9,924,631 ("631 Patent"), and 11,337,368 ("368 Patent"), and U.S. Design Patent No. 814,893 ("D893"), including without limitation TTi's non-infringement and invalidity defenses.

Torvent agrees to the following:

1. Torvent represents that, notwithstanding any transfers of ownership in the '249, D254, and D255 Patents, all royalty payments made by TTi for its sales of the 1st Generation and Fixed Head products reflected in the above-referenced sales reports have been accepted by Torvent and/or its predecessors-in-interest and satisfy any and all obligations of the 2007 License Agreement and any amendments thereto with respect to those sales reflected in the Sales Report (TTi00004805).
2. Torvent agrees to dismiss all claims based on the '249, D254, and D255 Patents with prejudice.
3. Nothing herein shall be construed as affecting Torvent's claims alleging infringement of the '807 Patent, '631 Patent, '368 Patent, and D893 Patent.

Torvent, Defendants, and Torvian agree that:

1. None of the parties will seek construction of any term of any claim of the '249, D254, and D255 Patents. However, nothing herein shall be construed as affecting either parties' ability to seek construction of any term of any claim of the '807 Patent, '631 Patent, '368 Patent, and D893 Patent.
2. TTi maintains its position that that the 2007 License Agreement did not terminate and remains enforceable and nothing in this agreement should be construed as preventing TTi's ability to advance that argument.
3. Torvent maintains its position that the 2007 License Agreement terminated in 2014, and/or was terminated, extinguished, repudiated, exhausted, and/or otherwise rendered unenforceable due to the actions, including materials breaches, by TTi, and that, in any event, did not and does not encompass or include the '807 Patent, '631 Patent, '368 Patent, and D893 Patent and continuations thereof, and nothing in this agreement should be

construed as preventing Torvent's, Torvian's, or First-to-Invent's ability to advance these arguments.

Therefore, pursuant to Fed. R. Civ. P. 41(a)(1)(A)(ii) and 41(c):

- Torvent hereby dismisses all claims based on U.S. Patent Nos. 8,025,249, D598,254, and D598,255 against all Defendants with prejudice.
- TTI hereby dismisses its (1) First Counterclaim (as stated in Dkt. 83) and First Third Party Claims (as stated in Dkt. 84) seeking declaratory judgment of non-infringement with prejudice; and (2) Third Counterclaim (as stated in Dkt. 83) and Third Party Claim (as stated in Dkt. 84) based on unjust enrichment against Torvent, Torvian, and First-to-Invent with prejudice.

SO ORDERED, this 1st day of November, 2022.

s/ Jon P. McCalla
Honorable Jon P. McCalla
U.S. District Court Judge

Respectfully submitted,

Dated: September 30, 2022

BAYARD, P.A.

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and Defendant Walmart Inc.*